

COPYRIGHT & TRADEMARKS

TRADEMARKS: VOLUME 1

FALL 1998

Professor Rosemary J. Coombe*

FACULTY OF LAW
UNIVERSITY OF TORONTO

FOR THE CLASSROOM USE OF UNIVERSITY OF TORONTO STUDENTS ONLY

OCT 27 MASS

ENVIRON OF TEMANO

BORA LASKIN LAW LIBRARY UNIVERSITY OF TORONTO

COPYRIGHT & TRADEMARKS

TRADEMARKS: VOLUME 1

FALL 1998

Professor Rosemary J. Coombe*

FACULTY OF LAW
UNIVERSITY OF TORONTO

FOR THE CLASSROOM USE OF UNIVERSITY OF TORONTO STUDENTS ONLY

Digitized by the Internet Archive in 2018 with funding from University of Toronto

TRADEMARKS AND UNFAIR COMPETITION

Fall 1998

Professor Rosemary Coombe

Volume I

Introduction, Evaluation, and the Policy Framework

| Gordon Henderson, "An Overview of Intellectual Property" (1993) | 1 |
|--|------|
| Keith Aoki, "Authors, Inventors and Trademark Owners: Private | |
| ntellectual Property and the Public Domain, Part II" (1994) | 7 |
| Common Law Marks: The Action for Passing Off | |
| Scott Joliffe, "The Common Law Doctrine of Passing Off" (1993) | . 22 |
| Erven Warnick BV v J. Townend & Sons (Hull) Ltd | 37 |
| nstitut National des Appellations d'Origine des Vins et Eaux-de-Vie v.Andres Wines Ltd | . 47 |
| Cadbury Schweppes Pty Ltd. v Pub Squash Co Pty Ltd | 49 |
| Consumers Distributing Co. Ltd. v. Seiko Time Canada Ltd | 59 |
| Reckitt and Colman Products Ltd. v. Borden Inc | . 72 |
| Paramount Pictures Corp. v. Howley et al | 79 |
| Reputation | |
| Orkin Exterminating Co. Inc. v. Pestco Co. of Canada Ltd | . 86 |
| Valt Disney Productions v. Triple Five Corp. (Alta. C.A.) | 101 |
| Common Field of Activity | |
| AcCulloch v L.A. May Ltd | 106 |
| Harrods Ltd. v. Harrodian School Ltd | 109 |
| isa International Service Association v. Visa Motel Corporation | 118 |
| Valt Disney Productions v. Fantasyland Hotel Inc | 121 |
| | |

Evidentiary Questions

| Unitel Communications Inc.v. Bell Canada | 125 |
|---|-----|
| J. Guy Potvin and Alain M. Leclerc, "Survey Evidence - A Tool of Persuasion" (1992) | 134 |
| The Registered Trade-mark System | |
| William Hayhurst, "What is a Trade-mark? The Development of Trade-mark Law" (1993) | 143 |
| James Kokonis, "The Scheme of the Canadian Trade-marks Act" (1993) | 146 |
| Lynda Covello, Flow Chart of Canadian Trade-marks Act (1991) | 155 |
| Selecting a Trade-mark | |
| | |
| Donna White, Clearing a Trade-mark (1995) | 156 |
| Choosing a Mark: Meeting Statutory Criteria | |
| Section 12, Trade-marks Act | 160 |
| Clearly Descriptive or Misdescriptive | |
| Deputy A-G Canada v. Biggs Laboratories (Canada) Ltd | 161 |
| Pepsi-Cola Co. of Canada v. Coca-Cola of Canada | 162 |
| Home Juice Co. v. Orange Maison Ltée | 163 |
| Abercrombie & Fitch Company v. Hunting World, Inc. | 167 |
| S. C. Johnson & Son, Ltd. v. Marketing International Ltd | 170 |
| John Labatt Ltd. v. Molson Cos. Ltd | 175 |
| Janet Fuhrer, "Evidence Required to Obtain and to Maintain Certain Trade-mark Registrations" (1997) | 177 |
| Functionality | |
| Pizza Pizza Ltd. v. Canada (Registrar of Trade-marks) | 190 |
| Remington Rand Corp. v. Philips Electronics N.V | 197 |
| Sega Enterprises, Ltd. v. Accolade, Inc | 200 |

| Ethan Horwitz, "US: Functionality versus Distinctiveness" (1993) | 206 |
|---|-----|
| Living Individuals (or Recently Dead Ones) | |
| Cooper v. Mark's Work Wearhouse Ltd | 210 |
| Jerome Alexander Cosmetics Inc. v. Giovanni Management Canada Ltd | 213 |
| Jean Cacherel v. Reitmans | 215 |
| Baron Philippe de Rothschild v. Casa de Habana Inc. | 219 |
| Obscene or Immoral | |
| Miss Universe, Inc. v. Bohna | 222 |
| Paul Loving, "Native American Team Names in Athletics: It's Time to Trade these Marks" (1992) | 225 |
| Kimberley Pace, "The Washington Redskins Case and the Doctrine of Disparagement: How Politically | |
| Correct Must a Trademark Be?" (1994) | 238 |
| Nel Newton, "Memory and Misrepresentation: Representing Crazy Horse" (1997) | 245 |
| Rosemary Coombe, <u>Cultural Appropriations</u> (1997) (excerpts) | 259 |
| Primarily Merely Name or Surname | |
| Gerard Horn Investments Ltd. v. Canada (Registrar of Trade-marks) | 277 |
| Juneau v. Les Chutes Corp | 290 |
| Procter & Gamble Inc. v. Nabisco Brands Ltd | 293 |
| Nationwide Manufacturing Ltd. v. Robert Morse Appliances Ltd | 296 |
| McDonald's Corp. v. Coffee Hut Stores Ltd | 299 |
| Acquired or Secondary Meaning | |
| Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd | |
| Carling Breweries Ltd. v. Molson Companies Ltd | 314 |
| Nicholas Fyfe, "Intellectual Property Seminar + Trade-mark Law | |
| Distinctiveness" (1993) | 319 |
| Janet Fuhrer, "Evidence Required to Obtain and to Maintain Certain Trade-mark Registrations" (1997) | 326 |

Opposing the Registration of a Mark

| Donna White, "Third Party Objections to Registration: An Overview of Opposition Procedure" (1995) | 330 |
|---|-----|
| Brian Gray, "Oppositions and Post-Registration Attacks" (1993) | 344 |
| Excerpt on the Issue of Consent | 350 |
| | |
| Confusing with a Registered Trade-mark | |
| December 11 december 12 de la Company | 251 |
| Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp | 331 |
| Molson Companies Ltd. v. John Labatt Ltd. 357 | |
| Gigi Inc. v. Bigi (Can.) Ltd | 361 |
| Leaf Confections Ltd. v. Maple Leaf Gardens Ltd | 368 |
| Leaf Confections Ltd. v. Maple Leaf Gardens Ltd | 379 |
| Nabisco Brands Ltd. v. Mr. Crispy's Inc | 380 |
| Helene Curtis Ltd. v. Revlon (Suisse) S.A | 383 |
| McDonald's Corp. v. Coffee Hut Stores Ltd | 385 |
| Charles of the Ritz Group Ltd. v. C and W Garments (Canada) Ltd | 390 |
| | |
| Not Person Entitled: Use and Proposed Use | |
| Lin Trading Co. Ltd. v. CBM Kabushiki Kaisha | 394 |
| McCabe v. Yamamoto & Co. (America) Inc | 399 |
| Daniel Bereskin, "Trade-mark Use" (1993) | 413 |